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PATENT
Customer No. 22,852
Attorney Docket No. 06502.0342-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
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Manish KALBANDE et al.)	Group Art Unit: 3692
)	
Application No.: 09/867,645)	
)	Examiner: Liversedge, Jennifer L.
Filed: May 31, 2001)	
)	
For: METHODS AND SYSTEMS FOR)	Confirmation No. 7993
DELIVERY OF INFORMATION)	
UPON ENROLLMENT IN AN)	
INTERNET BILL PRESENTMENT)	
AND PAYMENT ENVIRONMENT)	

Attention: Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF

Pursuant to 37 CFR § 41.41(a)(1), Appellants present this Reply Brief in response
to the Examiner's Answer mailed on September 5, 2007.

I. Status of Claims

In response to the Appeal Brief filed on April 23, 2007, the Examiner has maintained the rejection of claims 8-10 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,578,015 to Haseltine et al. ("*Haseltine*"); the rejection of claims 1-7 and 14-20 under 35 U.S.C. § 103(a) as being unpatentable over *Haseltine* in view of PR Newswire, "Sun-Netscape Alliance's New Internet Billing Consolidation Application to Help Make Internet Billing a Reality for Consumers" ("*Newswire*"); and the rejection of claims 11-13 and 21-29 under 35 U.S.C. § 103(a) as being unpatentable over *Haseltine*.

II. Response to Examiner's Arguments in the Answer

In addition to the arguments for reversal of the outstanding final rejection provided in Appellants' Appeal Brief filed on April 23, 2007, Appellants provide the following remarks regarding the Examiner's Answer ("Answer") mailed on September 5, 2007.

Regarding the rejection of claim 8 under 35 U.S.C. § 102(e), the Examiner continues to assert that *Haseltine* discloses the claimed "biller-independent submodules" and "biller-dependent submodules" (Answer at pages 14-16). This is not correct.

Appellants continue to submit that thick consolidator 350 and thin consolidator 360 are part of the consolidator module, not the biller module, as depicted in Fig. 3. In addition, when the bill data requested by the customers is not available, the thin consolidator "refer[s] the customer to the biller's own Web site for further detailed bills." (col. 2, lines 39-41). To successfully refer the customer to the biller's own Web site, "the thin consolidator may also maintain a customer-accessible link to" the biller's Web site (col. 11, lines 2-3). The customers then directly connect to the biller's Web site and

obtain “detailed bill information independently of the thin consolidator” (col. 11, lines 11-15) (emphasis added).

Thus, *Haseltine* does not teach the claimed “biller-independent submodules” and “biller-dependent submodules.” Direct connection by the user to the billers’ Web site as taught by *Haseltine* also teaches away from the claimed “biller dependent modules for retrieving information from data stored by the biller.” Therefore, *Haseltine* does not teach or suggest “biller-dependent modules for retrieving information from data stored by the biller; and an interface enabling the biller-independent submodules to interact with the biller-dependent submodules,” as further recited in claim 8.

Regarding the rejection of dependent claim 9, the Examiner maintains that col. 5, lines 15-23 and col. 10, lines 25-33 of *Haseltine* disclose the claimed “client object” (Answer at page 16). Appellants continue to disagree with the Examiner’s position.

A website where a customer can view and pay bills does not teach or suggest the claimed “client object.” *Haseltine* discloses a relational database and does not disclose embodiments implemented as other type of databases. Appellants submit that no objects are disclosed by *Haseltine*. Therefore, *Haseltine* does not teach or suggest the claimed “a client object, connected to the bill presentment and payment module,” as recited in claim 9.

Claim 10 depends from claim 9. As explained, *Haseltine* does not support the rejection of claim 9. Accordingly *Haseltine* also does not support the rejection of claim 10 for at least the same reasons set forth above in connection with claims 8 and 9. Accordingly, *Haseltine* cannot anticipate claims 8-10. Therefore, Appellants respectfully request that the Board reverse the rejection of claims 8-10 under 35 U.S.C. § 102(e).

Regarding the rejection of claims 1-7 and 14-20 under 35 U.S.C. § 103(a), Appellants continue to submit that a *prima facie* case of obviousness has not been established. The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original). In this application, a *prima facie* case of obviousness has not been established because the Examiner has not clearly articulated a reason why one of ordinary skill would find the claimed combination obvious in view of the cited references.

Regarding the rejection of claim 1, the Examiner asserts, “[w]hen a user registers with the consolidator system on the consolidator web site, the information must be provided to the biller” (Answer at pages 16-17). Even assuming that this is correct, claim 1 requires “providing the customer identification information to one of the billers as part of a first request.”

Appellants submit that customers may register themselves to the bill presentment and payment database in two ways. First, “[c]ustomers wanting to view and pay bills may register themselves by accessing an HTML registration page” (col. 8, lines 65-66). Second, “billers may supply the necessary customer information and enroll or register customers in a batch mode by loading the customer data into an interface provided in the staging area 420 over” http or ftp (col. 8, line 67 - col. 9, line 5).

In both enrollment methods, the customers log onto the system where the database is maintained. Logging onto the system is a request. However, because the customers log onto the system where the enrollment data is stored, the customer does not provide identification “information to one of the billers as part of a first request indicating enrollment.” Any customer information in *Haseltine* is provided at an HTML registration page or staging area 420 as previously stated. The HTML registration page and staging area 420 are not present within the billers.

Col. 9, lines 11-13 of *Haseltine* disclose accessing a web site for bill presentation and payment service after the customer is enrolled. Any transmission of customer information to the biller occurs after the customer is enrolled in the bill presentation and payment system. Customer enrollment in the system, which appears to be a request, occurs without the transmission of a request to the biller. The subsequent transmission of information to biller is not a “first request indicating enrollment in the bill presentment and payment system.”

Therefore, even assuming that the act of sending information from the consolidator to the biller constitutes a request, which Appellants do not concede, *Haseltine* does not teach or suggest “providing the customer identification information to one of the billers as

part of a first request indicating enrollment in the bill presentment and payment system," as recited in claim 1 (emphasis added). In view of the deficiencies of the cited references, the Examiner has not clearly articulated a reason why the claimed combination would have been obvious to one of ordinary skill.

Claims 2-5 depend from claim 1. As explained, the cited art does not support the rejection of claim 1 under 35 U.S.C. § 103(a). As such, the cited art does not support the rejection of claims 2-5 for at least the same reasons set forth in connection with the response to the rejection of claim 1.

Regarding claim 2, the Examiner asserts that the user "makes a request for registration" and "makes a request for displaying and paying a bill" (Answer at pages 17-18). Appellants submit that a user request for registration does not teach or suggest the claimed "first request." Moreover, the URL in *Haseltine* merely provides the location information of the billers' Web site. Thus, when customers click the customer accessible link, the customers' browsers send HTTP requests directly to the billers' Web site using the location information from the link without any further participation or processing from the consolidator. Accordingly, maintaining the customer accessible link cannot constitute "transmitting a second request to the one of the billers to access billing information," as recited in claim 2. Nor has the Examiner clearly articulated a reason why the claimed combination would have been obvious to one of ordinary skill.

Independent claim 14, though of different scope from claim 1, recites elements similar to those set forth above with respect to claim 1. Claim 14 is therefore allowable for at least the reasons presented above. Claims 15-18 are also allowable at least due to their dependence from claim 14.

Regarding claim 6, the Examiner asserts that *NewsWire* discloses “data [that] can be sent and/or received at anytime” (Answer at page 19). Appellants submit that the Examiner has mischaracterized *NewsWire*.

The online banking site of *NewsWire* receives bills from the service providers once the billing period ends. When the bills are received, the banking site can post the bills for the customer to view as often as he would like. However, the fact that the bills can reach the customer more than once a month (i.e. allowing the customer to view the bill many times), does not mean that the online banking site receives the information at an unscheduled time. On the contrary, the information is received at the end of the billing cycle and can be viewed or paid by the customer at any time. Therefore, *NewsWire* does not teach or suggest “forwarding the retrieved information to the requesting IBPP system at an unscheduled time,” as recited in claim 6. Nor has the Examiner clearly articulated a reason why the claimed combination would have been obvious to one of ordinary skill.

Accordingly, *Haseltine* and *NewsWire* fail to establish a *prima facie* case of obviousness with respect to claim 6. Claim 7 depends from claim 6 and is thus also allowable for at least the same reasons as claim 6.

Independent claim 19, though of different scope from claim 6, recites limitations similar to those set forth above with respect to claim 6. Claim 19 is therefore allowable for at least the reasons presented above. Claim 20 is also allowable at least due to its dependence from claim 19.

Regarding the rejection of claim 11, the Examiner continues to assert that “it is the consolidator that is facilitating the contact with the biller” (Answer at page 19). The consolidators of *Haseltine* do not make requests to the billers in response to customers

requests. Col 11, line 5-14 discloses, “thin consolidator 360 may maintain a customer-accessible link to the billers.” However, as explained earlier, when the customers use the customer accessible link in the form of a URL, it is the customers that make direct requests to the billers.

Haseltine explicitly states, “the thin consolidator may include a URL linking the customer 380 directly into a Web page containing the customer's 380 (detailed) billing data, thereby conveniently providing the customer 380 with detailed bill information independently of the thin consolidator 360” (col. 11, lines 9-14) (emphasis added). Therefore, the Examiner is incorrect in asserting that *Haseltine* discloses an example wherein the consolidator module requests information from the biller and that the consolidator is requesting account information for a particular customer that is maintained at the biller site.

Further, in rejecting claims 11 and 12, the Examiner continues to assert that “a server object, which receives a request from the consolidator module,” “a request handler, connected to the server object,” and “an implementation object which receives the request from the request handler” would have been obvious in order to “execute the disclosed example, yielding a tangible result” (Answer at page 9). Appellants disagree with the Examiner's position.

One of ordinary skill in the art would not have modified *Haseltine* to arrive at the claimed combination. That is, the cited prior art would not render obvious “a server object, which receives a request from the consolidator module,” “a request handler, connected to the server object,” and “an implementation object which receives the request from the request handler,” as recited in claims 11 and 12.

To establish a *prima facie* case of obviousness, the Examiner must, among other things, ascertain the differences between the claimed invention and the prior art. See M.P.E.P. § 2144.08(II)(A). As demonstrated above, the Examiner has mischaracterized the differences between Appellants' claims and prior art. Since the Examiner has not properly ascertained the differences between the prior art and the claims, the Examiner has not clearly articulated a reason why one of ordinary skill would find the claimed combination obvious in view of the cited references. Therefore, no *prima facie* case of obviousness, based on *Haseltine*, can be established for these claims.

Appellants submit that the arguments regarding claims 1-5 and 14-18 also apply to independent claims 21 and 23 and dependent claims 24-27. Therefore, no *prima facie* case of obviousness, based on *Haseltine*, can be established for these claims.

Regarding the rejection of claim 22, Appellants continue to submit that any IBPP system that may exist in *Haseltine* includes the Web site where the customer can view and pay bills and the thick consolidator 350, at least because the bills cannot be presented and paid without Web site interaction.

Any "receiving," "retrieving," and "providing" that may exist in the cited portions of *Haseltine* are located within the IBPP system. Any implied request is received by the IBPP system, which also displays the bills for viewing payment. Any "retrieving" and "providing" occurs at the Web site. Even assuming that the steps of "receiving," "retrieving," and "providing" are present, which Appellants do not concede, they occur within the IBPP system. Therefore, *Haseltine* does not teach or suggest "receiving, from the requesting IBPP system, a request" at least because any receiving in the cited portions of *Haseltine* occurs by the IBPP. Moreover, *Haseltine* does not teach or suggest

"providing the retrieved data to the requesting IBPP system," as recited in claim 22, at least because any providing in the cited portions of *Haseltine* occurs by the IBPP, and the IBPP does not provide data to itself. For at least the above reasons, the Examiner has not clearly articulated a reason why one of ordinary skill would find the claimed combination obvious. The rejection of claim 22 under 35 U.S.C. § 103(a) based on *Haseltine* is therefore improper.

Independent claim 28, though of different scope from claim 22, recites limitations similar to those set forth above with respect to claim 22. Claim 28 is therefore allowable for at least the reasons presented above. Claim 29 is also allowable at least due to its dependence from claim 28.

III. Conclusion

For the reasons given above, and those reasons provided in Appellants' Appeal Brief, Appellants respectfully submit that the rejections of claims 1-29 are in error and should be reversed.

If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: November 5, 2007

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